

**Remarks:**

Claims 1-94 were pending in this application at the time of the outstanding September 30, 2003 Office Action. By this amendment, claims 41, 43, 47, 51, 58, 62, 65, 76, 80, 83, 87, 88, 89, 90, 92, 93, and 94 are amended as shown in the preceding claims listing. Further, new claim 95 is added. Thus, the currently pending claims are claims 1-95. No new matter is present herein.

Also, Applicant respectfully requests that the Examiner grant Applicant and Applicant's counsel an opportunity for a personal interview prior to picking up this amendment for action to discuss the patentability of the claimed invention in view of the cited references. In that regard, the Examiner is respectfully requested to telephone applicant's undersigned representative, Richard Haferkamp, at 314-552-6272 during normal business hours, CST, to arrange an interview.

The 9/30/03 Office Action rejected all pending claims of this application as follows:

- (1) claims 1-40, 45-46, 51-61, and 65-94 (including independent claims 1, 24, 35, 45, 51, 58, 65, 69, 76, 80, 83, 87, 88, 89, 90, 92, 93, and 94) were rejected for obviousness based on U.S. Patent No. 5,794,207 (Walker et al.) in view of U.S. Patent No. 6,125,384 (Brandt et al.), and further in view of the 1995 news snippet Many Ways to Sell;
- (2) claims 41-44 and 47-50 (including independent claims 41, 43, and 47) were rejected for obviousness based on the Walker patent in view of the Many Ways to Sell snippet; and
- (3) claims 62-64 (including independent claim 62) were rejected for obviousness based on the Walker patent in view of the Brandt patent.

Applicant thanks the Examiner for this action indicating that the Office has abandoned the prior rejections and has thus been persuaded by Applicant's previous submittal and argument. However, Applicant respectfully disagrees with these rejections for the reasons expressed below. In particular, Applicant respectfully submits that the newly cited prior art is deficient and that a person having ordinary skill in the art would not have been motivated to combine the references in the manner suggested by the Office Action. Instead, the references themselves teach away from their being combined.

***I. The "Many Ways to Sell" News Snippet and the Walker Patent:***

The news snippet "Many Ways to Sell" includes a sentence that reads: "ARMS, or the Automated Rental Management System, allows insurance companies to do business with Enterprise electronically, including making reservations, rental extensions, billing, and payment."

The ARMS system to which this snippet refers was not internet based. And, it did not provide insurance company purchasers of rental vehicle services with the ability to select a rental vehicle service provider for a reservation from among a plurality of rental vehicle service providers. The ARMS system described in the Many Ways to Sell snippet only allowed an insurance company employee to place a reservation with a single rental vehicle service provider. (See Paragraph 5 of "Declaration B of David Smith" included herewith).

The Walker patent discloses a system designed to allow a buyer to submit a single conditional purchase offer (CPO) to multiple sellers. Walker also discloses a rental vehicle CPO as an example. (See Walker; col. 16, line 6). The CPO details what the buyer wants and the conditions under which the buyer will buy. (See Walker; col. 8, lines 46-56). To effectuate the transaction that is the subject of a CPO, a seller needs to review the CPO and evaluate whether it is worthy of acceptance (i.e., are the price and conditions agreeable to the seller?). (See Walker; col. 9, lines 17-30). Once accepted, the Walker system creates what is deemed to be a legally enforceable contract (reservation) between the buyer and seller. The Walker patent also discloses that the system should provide the seller with the ability to issue a counteroffer to the buyer. (See Walker; col. 22, lines 52-63). There is no teaching present in the Walker patent that describes how the acceptance process can be automated; that is, under Walker, human intervention is required for a seller to accept a CPO.

Sellers can obtain CPOs of interest for their review by either browsing a CPO database or by configuring the system to automatically forward CPOs of interest to them. (See Walker; col. 18, lines 15-33). Thus, the Walker system relates to a "buyer-driven" market whereby multiple sellers will presumably compete to accept an offer from a buyer that is set on the buyer's terms. Essentially, there is a race such that the first seller to accept the buyer's terms wins the sale. (See Walker; col. 9, lines 24-30). Thus, the buyer does not control, or choose in any meaningful way, the particular seller he wishes to place the reservation with.

Under Walker's reverse auction system, a buyer can "lowball" his/her buying price relative to the imposed buying conditions (e.g., \$30 a night for a 4 star hotel room in midtown Manhattan) in the hope of there being a seller willing to accept the offer. Because the Walker system allows the CPO to be ***multicast to numerous potential sellers (or numerous potential sellers may browse the database for CPOs of interest)***, the buyer has a hope of finding a seller willing to accept his/her CPO with a minimum of effort on the part of the buyer. In a system such as this, sellers are disadvantaged by the fact that the buyer is setting the price and conditions of the sale. ***Accordingly,***

***it must be reiterated: the essence of the Walker patent is that it teaches a "buyer-driven" market for a buyer to submit a single CPO for review by multiple sellers. The buyer has no control over who the seller is other than it is one of a group of potential sellers, and there must of necessity be several communications sent between buyer and seller, and in some instances more than several in the event of counteroffers.***

In rejecting claims 1-61 and 65-94, the Office Action states that it would have been obvious to a person of ordinary skill in the art to combine the Walker system with the Many Ways to Sell ARMS description to obtain an automated rental vehicle transaction system that communicates rental vehicle reservations to one of a plurality of competitive providers of said rental vehicle services. The Office Action states that such a skilled person would be motivated to make the combination for the purpose "of allowing [an] authorized user to provide reliable and dependable service to [a] customer involved in [a] rental car insurance claim". (See Office Action; page 4, lines 6-7). This same motivation is used to support the obviousness rejections of independent claims 1, 24, 35, 41, 43, 45, 47, 51, 58, 65, 69, 76, 80, 83, 87, 88, 89, 90, 92, 93, and 94.

***II. The Office Action fails to set forth a valid motivation for combining the Walker patent and the Many Ways to Sell news snippet:***

Applicant respectfully submits that a person of ordinary skill in the art would not be so motivated to combine the Walker system with the ARMS system of the Many Ways to Sell snippet. When presenting a motivation used to combine references in an obviousness rejection, the Office Action's evidence of that motivation must be "***clear and particular***". In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed.Cir. 1999) (the showing [of a source for motivation] must be ***clear and particular***. [citations omitted]. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'.").

Applicant submits that the motivation asserted in the Office Action (to allow an "authorized user to provide reliable and dependable service to [a] customer involved in rental car insurance claim") is insufficiently particular to satisfy this requirement. This motivation is so general as to vitiate the motivation requirement altogether. There is no particularized finding as to a specific reason why a skilled person would choose to incorporate Walker's CPO submission technique into Many Ways to Sell's ARMS description.

As the USPTO has highlighted in its own guidelines for examining business method claims for obviousness, such general motivation statements are insufficient to support an obviousness

rejection "because it could cover almost any alteration contemplated of Reference A and does not address why [the Office Action's] specific proposed modification would have been obvious. (See USPTO "Formulating and Communicating Rejections Under 35 USC 103 for Applications Directed to Computer-Implemented Business Method Inventions"; Section V; Example 17; <http://www.uspto.gov/web/menu/busmethp/busmeth103rej.htm>). In fact, Applicant can see no reason as to how "reliability" and "dependability" are positively affected by any combination of Walker with Many Ways to Sell. Therefore, Applicant respectfully submits that the obviousness rejection of claims 1-61 and 65-94 lacks merit because the Office Action fails to provide a particularized motivation to combine the Walker patent and the Many Ways to Sell snippet in the manner suggested by the Office Action. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("**particular findings** must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." (emphasis added)).

**III. A person of ordinary skill in the art would not be motivated to combine the Walker patent with the Many Ways to Sell news snippet because the implementation of Walker's buyer-driven market in an insurance company-to-rental car company system for creating and managing rental car reservations, such as that described in the Many Ways to Sell news snippet, would significantly degrade the quality of service provided by such a reservation creation/management system.**

In fact, upon a review of the Walker patent and Many Ways to Sell news snippet, Applicant asserts that a skilled person would not be motivated to incorporate Walker's technique of submitting a CPO to multiple sellers into the Many Ways to Sell ARMS system to achieve the limitations of claims 1-95 because the use of Walker's CPO submission technique would result in the elimination of the efficiency and certainty provided by the automated reservation processing aspects of the claims. Under Walker, **human intervention** and review is required before a CPO can be accepted, thereby requiring not only time to review and analyze the CPO but also multiple communications to consummate a reservation. (See Walker, col. 18, line 15 – col. 19, line 12). However, with the 1995 ARMS system, high volume reservation handling with minimal communications, thereby permitting an insurance adjuster to place his reservations with the rental car company of his choice, was one of its primary purposes. (See Declaration B of David Smith; paragraphs 5; 7). If the 1995 ARMS system of the Many Ways to Sell snippet were combined with the Walker CPO system, the efficiency of the 1995 ARMS system's abilities to process high volumes of rental car reservations would be entirely lost because rental car employees would be

required to review incoming CPOs or browse a database of CPOs to find which CPOs are worthy of acceptance, analyze the CPO and determine its acceptability, and then either ignore or counteroffer the CPO. (See Walker; col. 18, lines 15-33). Further still the certainty with which insurance company purchaser can create reservations would be lost because any reservation request in the form of a CPO issued by the insurance company purchaser may be rejected by Enterprise as being unacceptable. Worse yet, the reservation request could end up being the subject of counteroffers as per Walker's teachings (see Walker; col. 22, line 52 – col. 23, line 16), thereby initiating additional communications and further reducing the efficiency of the 1995 ARMS system. Not only that, but an insurance adjuster would lose his ability to choose the rental car company he wanted to handle the reservation. Thus, a person of ordinary skill in the art would not be motivated to combine the Walker patent with the Many Ways to Sell snippet because the incorporation of Walker's teachings into a business modality such as that of the 1995 ARMS system would severely detract from the value of the 1995 ARMS system. (See Declaration B of David Smith; paragraph 9).

The very "buyer-driven" nature of the Walker system would motivate a skilled person in the art *not* to incorporate its teachings into the 1995 ARMS system. As noted above, the transformation of the 1995 ARMS system into a buyer-driven system as taught by Walker would severely impact the efficiency of the 1995 ARMS system so as to negate its value. Moreover, a person of ordinary skill in the art would not be motivated to modify the Walker technology to remove its "buyer-driven" market because, as is well-known, if a proposed modification to a prior art reference would render that prior art invention unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984); *see also* MPEP §2143.01. Accordingly, a person of ordinary skill in the art would not be motivated to modify the Walker system so as to eliminate its purpose of creating a "buyer-driven" market.

***IV. A person of ordinary skill in the art would not be motivated to combine the Walker, Brandt, and Many Ways to Sell references because of the different business modalities in which those three references operate.***

The shortcomings of the Brandt patent relative to the claimed invention were thoroughly discussed by Applicant in the amendment and response filed April 28, 2003 (see, for example, the Declaration of Russell Ditmar and the argument in that amendment and response based thereon), and Applicant reincorporates those points herein. Furthermore, Applicant respectfully submits that a person of ordinary skill in the art would not be motivated to combine the Walker patent, the

Brandt patent, and the Many Ways to Sell news snippet in the manners suggested in the Office Action.

As noted in paragraphs 8 and 9 of Declaration B of David Smith, there are vast differences between the business modalities of the Walker patent (a "buyer-driven" modality designed to implement a reverse auction), the Brandt patent (a modality by which a web user can book reservations for personal use), and the 1995 ARMS system (a modality in which insurance company personnel can remotely create and place a high volume of reservations with a buyer-selected rental car service provider on behalf of insured policyholders). Accordingly, a person of ordinary skill in the art would not choose to combine the business processes of these disparate references because each of these business modalities possesses its own unique set of business considerations, many of which are conflicting with the business considerations of the other business modalities.

For example, as noted above, because of the high volume nature of business modalities such as the 1995 ARMS system and because of the business considerations involved therein, a buyer-driven system of submitting buyer-specified CPOs for seller review, possibly resulting in counteroffers from the sellers, would be cumbersome and inefficient in the context of processing insurance-based replacement rental car reservations. This modification would actually increase substantially the volume of communications, the required amount of human involvement needed to analyze the CPOs, and lower the throughput capability. Furthermore, the buyer loses "mastery over his offer" and the ability to control which rental car company gets the reservation. Instead, the first seller to accept gets the reservation. (See Walker, col. 9, lines 17-30; col. 19, lines 13-28.) This effectively removes one of the important controls any high volume buyer has over any seller, that of curtailing or even losing all future business for failure to "satisfy" the buyer. Accordingly, a person of ordinary skill in the art would *not* possess a motivation to incorporate the Walker "buyer-driven" CPO market technology into a high volume, buyer selected, insurance-based replacement rental car reservation management system. (See Declaration B of David Smith, paragraph 9).

Further, because of the inter-company aspect of the insurance-based replacement rental car reservations business modality (which requires effective communications and data flow between the insurance company and multiple rental car service providers), the incorporation of business processes for a personal use rental car reservation system such as the one disclosed in Brandt would be ineffective. As noted in paragraphs 10 and 11 of the Russell Dittmar Declaration, the assignee of the Brandt system itself recognizes that the suitability of Brandt's technology does not extend to inter-company data communications. Accordingly, a person of ordinary skill in the art would not

inter-company data communications. Accordingly, a person of ordinary skill in the art would not be motivated to incorporate Brandt's technology into a business environment for which even Brandt's assignee believes the technology to be unsuitable. Simply put, a person having ordinary skill in the art would not be motivated to apply Brandt's technology in an environment such as that of the claimed invention because the Brandt system is not capable of operating effectively within that environment.

As is well-settled, "*all* of the relevant teachings of the cited references must be considered in determining what they fairly teach to one having ordinary skill in the art. [citations omitted] The relevant portions of a reference include not only those teachings which would suggest particular aspects of an invention to one having ordinary skill in the art, but also those teachings which would lead such a person away from the claimed invention." In re Mercier, 185 USPQ 774, 778 (CCPA 1975) (emphasis in original) (*see also* Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 227 USPQ 657,667, 669, fn 33 (Fed. Cir. 1985) (finding error by the district court where the district court's obviousness analysis used the claims as blueprint and failed to give "due consideration for teachings in [the prior art] references that would have led one skilled in the art to find it improper to combine [the prior art] references") A failure to heed these mandates results in an improper obviousness rejection of a claim based on selective hindsight wherein Applicant's claims are used against him as a map to navigate through isolated and unrelated disclosures in the prior art. Under this standard, Applicant notes that no teachings can be found in the cited references, expressly or implicitly, when considered individually or as a whole, that would lead one of ordinary skill in the art to modify the cited references to arrive at the limitations of claims 1-95. In fact, as discussed above, the teachings in these references would discourage such a person of ordinary skill in the art to combine the cited references because of the disparate nature of the business environments in which the systems of those references operate. Accordingly, Applicant respectfully submits claims 1-95, including all independent claims therein, define patentable subject matter over the cited references.

#### **Conclusion:**

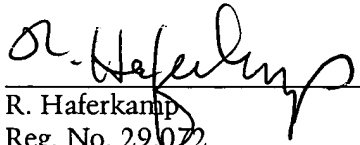
Therefore, for the foregoing reasons, Applicant respectfully submits that claims 1-95, including independent claims 1, 24, 35, 41, 43, 45, 47, 51, 58, 62, 65, 69, 76, 80, 83, 87, 88, 89, 90, 92, 93, 94, and 95, are patentable over the Walker, Many Ways to Sell, and Brandt references. One of ordinary skill in the art is not taught to combine the references in the manner suggested by

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the Office. There is no objective teaching in any reference identified by the Office that teaches their combination. Instead, as explained in detail above, and as supported by the Smith declaration attached, each has a business modality that actually teaches away from their being combined. While further specific comments could be made to further distinguish the claims from the newly cited prior art, such is not considered as necessary in view of the failure of these rejections at their outset to satisfy the judicial guidance on combining references. However, Applicant reserves the right to further address any specifics that the Office might need in order to determine the allowability of any one or more set of claims pending herein.

Favorable action is respectfully requested.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'R. Haferkamp', is written over a horizontal line.

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